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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,915	10/31/2006	Gerard Bradley	1022702-000294	7330

21839 7590 02/03/2010
BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

THOMAS, JAISON P

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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02/03/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/567,915	Applicant(s) BRADLEY ET AL.	
	Examiner Jaison P. Thomas	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-32 is/are pending in the application.
- 4a) Of the above claim(s) 33-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, Claims 20-32 and the species of Claim 28 in the reply filed on 10/21/2009 is acknowledged. The traversal is on the ground(s) that there is no burden upon the Examiner to search the non-elected claims and species. This is not found persuasive because of the reasons set forth in the Restriction requirement dated 10/1/2009. The Examiner respectfully submits that searching the non-elected method and article claims as well as the non-elected antistatic agents would require searches across numerous patent class and subclasses in order to address the embodiments recited. For examples, methods of melt processing and masterbatching could be found in Classes 523 and 524, composition claims found in Class 252, and electrostatic painted articles found in Class 118. The Examiner also reminds Applicants that if the elected composition claims are found allowable, the non-elected claims drawn to the same limitations would be rejoined and allowed.

The requirement is still deemed proper and is therefore made FINAL.

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Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the Examiner is unclear as to the endgroups found in the repeat units defined by Formulae IIa and IIb. For example, plugging in Formula IIa or IIb into the Formula I "PA" section would result in a structure having two adjacent carbonyl functional groups and this appears to be chemically incorrect. Amendment or explanation of said structure is requested.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 20-26,31 and 32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bastiaens et al. (US Patent App. Pub. No. 2003/0092824).

Bastiaens et al. teaches an conductive thermoplastic composition (Abstract) which contains up to 65 weight percent of polyamide (pg. 1, para. 0011), and combinations of electrically conductive filler of up to 40 weight percent. The reference notes that filler amounts can be optimized depending on filler type and final desired properties of the composition (pg. 3, para. 0032). Types of filler can include carbon black which can be used between 0.1 to 20 weight percent in the composition (pgs. 3-4, para. 0033) and conductive carbon fibers which are known to modify electrostatic discharge properties of resins, used in amounts ranging from 2 to 40 weight percent of the

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composition (pg. 4, paras. 0036-0037). Note that the Examiner construes this type of carbon fiber as equivalent to the "antistatic agents" required by Claim 20 broadly construed. The electrically conductive fillers can be masterbatched into the main composition via a thermoplastic resin (pg. 5, para. 0040). The composition can also contain impact modifiers with examples disclosed (pgs. 5-6, paras. 0041-0047). Examples of polyamides that can be used are also disclosed on pg. 3, para. 0028.

7. Claims 20-26 and 31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gueret et al. (US Patent 4549559).

Gueret et al. teaches a plastic composition which contains one plastic material, one plasticizer ranging from 25 to 100 percent of the amount of plastic material, and 3 to 20 percent carbon constituent (Claim 1, Cols. 4-5, lines 57-68 thru lines 1-5). The plastic material can be polyamide or polyamide 11 (Col. 5, lines 16-20). The plasticizer can be "Pebax" which is polyether sequenced with amide blocks (Col. 3, lines 22-24). The carbon constituent can be carbon black (Col. 3, lines 25-31).

8. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret et al. (US Patent 4549559).

In the alternative, Gueret et al. is relied upon as disclosed above, however, does not teach the specific repeat units or the specific constituents as required by Claims 28-30.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the the polyether-polyamide block copolymer (Pebax) of Gueret through routine experimentation for best results. As to optimization results, a patent will not be granted based upon the optimization of result effective variables when the optimization is obtained through routine experimentation unless there is a showing of unexpected results which properly rebuts the prima facie case of obviousness. See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). See also *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

9. Claims 20-26 and 28-32 are rejected under 35 U.S.C. 103(a) as obvious over Bouilloux et al. (US Patent 6025055).

Bouilloux et al. teaches flexible polyamide composition suitable for blow moulding (Abstract). The composition is comprised of polyamide, polyamide polyether block copolymer, and a crosslinked phase (Col. 2, lines 44-50) which include polymers such as grafted polyolefins such EPDM, SEBS, and SBS (Col. 5,

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lines 12-21). Polyamides and the block copolymers are described (Cols. 3-4, lines 1-67 thru lines 1-28). Examples A-H in Table 2 disclose samples which contain 39% of polyamide, 19.57 % of block copolymer and 1% of "MM black" which is described as a masterbatch of carbon black in VLDPE (Col. 9, lines 14-15).

Bouilloux is relied upon as disclosed above. However, Bouilloux does not teach a composition which contains 2 % of a electrically conductive filler or the pentyl radical requirement of Claim 29.

A *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties, see *Titanium Metals Corp. of America v. Banner*, 778F.2d 775,227 USPQ 773 (Fed. Cir. 1985). See MPEP 2144.051.

With respect to claim 29, the Examiner respectfully submits that any modification of the art, such as the use of a 5 carbon lactam in the production of the block copolymer in the art, is within the purview of the ordinarily skilled artisan and does not patentably distinguish the claim over the general teachings of the art.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaison P. Thomas whose telephone number is (571) 272-8917. The examiner can normally be reached on Mon-Fri 9:30 am to 6:00 pm.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. P. T./
Examiner, Art Unit 1796

/Mark Kopec/
Primary Examiner, Art Unit
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